

Application No. 09/264,432
Amendment "I" dated January 28, 2005
Reply to Office Action mailed December 2, 2004

REMARKS

Initially, Applicants would like to thank the Examiner for the courtesies extended during the recent interview held on January 12, 2005¹. The claim amendments made by this paper are consistent with the discussions and proposals presented during the interview.

By this paper 3 of the dependent claims have been amended to overcome minor technicalities. None of the independent claims have been amended however and no claims have been cancelled, such that claims 4, 5, 7, 8, 14, 15, 19, 33-42, 46, 47 and 49-71 remain pending for reconsideration.

In the latest Office Action mailed December 2, 2004, all of the pending claims 4, 5, 7, 8, 14, 15, 19, 33-42, 46, 47 and 49-71 were considered and rejected. Claims 4, 5, 7, 8, 14, 15, 19, 33-42, 46, 49-51, 53, 63, 64, 66, 67, 69 and 70 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perlman (WO 98/56128) in view of Bedard (U.S. Patent No. 5,801,747). Claims 46 and 52 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perlman, in view of Bedard, and in further view of Brown (U.S. Patent No. 5,887,133). Claims 54-58, 60-62, 65, 68 and 71 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Bedard. Claim 59 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Brown in view of Bedard and in further view of Gupta (U.S. Patent No. 6,487,538)².

Claims 8 and 38 were also rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement and claims 60-62 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The § 112

¹ It will be noted that the interview summary incorrectly identifies the date of the interview as January 5, 2005.

² Although the prior art status of the cited art is not being challenged at this time, Applicants reserve the right to challenge the prior art status of the cited art at any appropriate time, should it arise. Accordingly, any arguments and amendments made herein should not be construed as acquiescing to any prior art status of the cited art.

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rejections made to claims 60-62 have been overcome herein by amendment and, more particularly, by deleting the objected to language. The § 112 rejections to claims 8 and 38, however, should be withdrawn^o for at least the reasons discussed during the interview, and as summarized below. In particular, the text found in line 17 of page 16 thru line 9 of page 17 make it clear that the envisioned and described embodiments of the user profile can include only television viewing information as well as television viewing information in combination with other information, as claimed in claims 8 and 38 and as described on page 16 and 17.

During the interview, the examiner suggested that the term 'alternatively' in line 8 of page 17 essentially qualifies and limits the description found back in lines 17-21 of page 16, corresponding to other profile information, such that the 'alternative' user profile recited on page 17 cannot include the other information. Applicants respectfully disagree. Initially, the fact that the term 'alternatively' is found at the end of an entirely different paragraph (beginning at line 3 of page 17) suggests that it corresponds to the description of the paragraph where it is found. In this case, alternatively is found in a paragraph that simply clarifies to what degree the television viewing can be included in the overall profile, which neither excludes nor necessarily includes the other profile information of the previous paragraph. Accordingly, it is more likely that the term 'alternatively' merely qualifies the previous one or more sentences in the paragraph in which it is found. For example, the fact that "the user profile may include information relating to only the most recently viewed television programming", can be interpreted as an "alternative" to compiling the user profile over a period of time, and weighting the user profile based on how old the view television programming is, as previously described in that paragraph.

Accordingly, it is clear that the description provided on pages 16 and 17 clearly support embodiments in which the profile only includes television programming viewing information as

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well as embodiments that further include television viewing in combination with other profile information, such as demographic information, internet usage, geographical information and other information, as described. Therefore, in view of the foregoing, Applicants respectfully submit that the rejections based on 35 U.S.C. § 112 to claims 8 and 38 should be withdrawn.

Now, with regard to the substantive rejections based on the cited art of record, the Examiner has suggested that Bedard in combination with Perlman and/or Brown and Gupta teach or suggest the claimed invention. All of the rejections made to the pending claims clearly rely on the Examiner's assertion that Bedard teaches or suggests that "the profile is preferably limited with respect to the number [of] entries", thereby making it obvious "to 'include information related to only a most recently viewed television program, [as claimed] such that the television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisements.'" Applicants strongly disagree for at least the reasons articulated during the interview, as briefly summarized below.

Initially, Applicants point out that the disclosure in Bedard, which the Examiner is relying on to support his assertion, simply states:

"Again, this demonstrates how this novel method is weighted as far as viewer preference toward the most recently viewed entries 202." (Col. 6, ll. 2-4).

This disclosure, however, actually contradicts the Examiner's assertion. In particular, this citation makes it very clear that a plurality of multiple viewed entries are considered and weighted, rather than a single entry, which clearly teaches away from the recited claim language requiring that the profile includes "only" the most recently viewed program and "such that

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television programming viewed less recently than the most recently viewed television programming is not included in the profile for use in selecting the advertisement."³

During the interview, the examiner also pointed out that another newly referenced passage, which could also possibly support for his assertion, states:

"In yet another embodiment of the invention, the number of entries 202 may have a set numeric limit, such as eight." Col. 5, ll. 2-4.

However, this passage, like the previous one, clearly necessitates or at least suggests a plurality of entries is required. Applicants also point out that even though the disclosure indicates that number of entries may be limited to a number, such as eight, there is no suggestion or motivation provided in the art to actually interpret this passage as suggesting the number of entries be limited to only a single entry. In fact, the teachings and disclosure provided in Bedard actually teach away from such an extreme and improper interpretation. In particular, Bedard goes through a bit of detail describing an array of multiple entries that are automatically populated according to what is viewed by a viewer. (Col. 5 and 6) Certain portions of the disclosure are also dedicated to weighting the entries by moving them within the array. (Col. 5 and 6, Fig. 3). Accordingly, in view of this disclosure, which is significant, it is clear that by restricting the number of entries to only a single entry that the purposes for the array and weighting schemes are essentially rendered useless. Therefore, it is clear that much of the disclosure in Bedard teaches away from interpreting either of the cited passages as suggesting that a user's viewing profile is limited to only a single entry.⁴

³ Again, as mentioned above, it should be noted that the use of the term "only" in this limitation does not preclude the inclusion of information other than television viewing in the profile. Instead, the term "only" merely qualifies the television viewed information included in the profile, as clarified during the interview.

⁴ "The totality of the prior art must be considered, and proceeding contrary to accepted wisdom in the art is evidence of nonobviousness" MPEP 2145 X.D.3.

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During the interview, the Examiner suggested that Bedard could still make it possible to limit the number of entries to one, notwithstanding the disclosure regarding the array. In response to this argument, without arguing its merits, Applicants simply note that simply because something can be done, doesn't mean that the art is suggesting it should be done or that there would be a motivation for doing it. And, as stated above, Bedard clearly fails to provide any such motivation for limiting the number of entries to a single entry. In fact, as explicitly stated by Bedard, the "viewer preferences [are weighted] toward the most recently viewed entries", rather than a single entry. Col. 6, ll. 2-4, emphasis added.

Applicants also note that to try and interpret Bedard as teaching or suggesting that an advertisement is selected from a profile that is based on television viewing that considers only the most recently viewed television program would require the exercise of improper hindsight based on the Applicants disclosure found in their application, which is improper⁵. In particular, "The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure." MPEP 2143.

Accordingly, in view of the foregoing, in view of the extensive prosecution in this case, and the corresponding fact that these claims have been thoroughly searched and examined in their present condition, and that the subject matter of these claims was previously found allowable prior to these rejections and other rejections that have been overcome in the last action, Applicants respectfully submit that the rejections of record should now be withdrawn and that the pending claims should now be allowed.

⁵ In considering whether improper hindsight is being used, it is essential that the examiner "does not include knowledge gleaned only from applicant's disclosure." MPEP 2145 X.A.

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In the event that the Examiner finds remaining impediment to a prompt allowance of this application that may be clarified through a telephone interview, the Examiner is requested to contact the undersigned attorney.

Dated this 28 day of January, 2005.

Respectfully submitted,



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